

Application No.: 10/812,015

Docket No.: 2336-255

REMARKS

Applicants appreciate the Examiner's thorough review of the present application, and respectfully request reconsideration in light of the preceding amendments and the following remarks.

Claims 1-13 and 33-39 are pending in the application. Non-elected claims 14-32 have been cancelled without prejudice or disclaimer. Claim 7 has been rewritten in independent form including all limitations of base claim 1 without otherwise touching the merits. Claim 1 has been amended to better define the claimed invention. Claims 33-39 readable on the elected invention have been added to provide Applicants with the scope of protection to which they are believed entitled. New claims 33-39 find solid support in the original application, e.g., at original claims 5 and 7, page 16, lines 22-23 of the specification, and FIG. 4d. The Abstract has been revised to be compliant with commonly accepted US patent practice. No new matter has been introduced through the foregoing amendments.

The Examiner's statement regarding the Restriction Requirement found in paragraph 1 of the Office Action is noted. Basically, the Examiner states that Inventions I and II are distinct and therefore, restrictable. The Examiner, however, has failed to address Applicants' argument that examination of the entire application can be made without serious burden on the Examiner.

The Examiner is kindly reminded that the arguable fact that the Inventions are distinct *alone* is *not* sufficient for requiring restriction.

Every requirement to restrict has two aspects:

(A) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claimed are either independent or distinct; and

(B) the reasons for insisting upon restriction therebetween. See MPEP, section 808 (emphasis added).

The Examiner further kindly reminded that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even

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though it includes claims to independent or distinct inventions. See MPEP, section 803 (emphasis added).

In this case, the Examiner's reason for insisting upon restriction, i.e., different classifications, is not persuasive. It is sufficient to note that the primary reference of *Orita* applied against claims 1-12 readable on Invention I is classified in class 438, subclass 22 which, according to the Restriction Requirement, is the classification of Invention II. This clearly demonstrates the Examiner's ability to search across multiple classes/ subclasses without any serious burden. The applied reference of *Orita* also confirms Applicants' view of the related art that references often describe both device and manufacturing method, and therefore no additional or burdensome search would be required. See, for example, *Orita* at the claims where the manufacturing method is described, and the portions relied upon in the Examiner's art rejections where the device is disclosed.

Accordingly, Applicants respectfully submit that the Restriction Requirement is improper because examination of the entire application can be done without serious burden on the Examiner. Withdrawal of the Restriction Requirement and consideration of non-elected claim 13 are in order.

The 35 U.S.C. 102(b) rejection of claims 1-6, 8 and 11 as being anticipated by *Orita* is believed overcome in view of the above amendments. See, for example, the "upper clad layer" 17B and the "alloy layer" 18a in FIG. 2 of *Orita*. The claimed invention is superior to the structure of *Orita* in the Ohmic contact feature due to a larger area of the alloy layer. Withdrawal of the 35 U.S.C. 102(b) rejection is now believed appropriate and therefore respectfully requested.

As to claim 6, Applicants respectfully submit that the applied reference clearly fails to teach or suggest the claimed ZnMg. See, for example, the passages cited by the Examiner at column 9, lines 16-21 and column 10, lines 33-42. It should be noted that Zn mentioned at column 10, line 30 is a p-type dopant of the p-type semiconductor layer, rather than a component of the alloy layer.

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The 35 U.S.C. 103(a) rejection of claims 7, 9-10 and 12 is traversed, because the Examiner has failed to provide an adequate suggestion or motivation to modify the reference. The language found at page 5, lines 8-9 of the Office Action, i.e., "by adjusting the thickness of the alloy layer and the metal layer in order to have the desired thickness," cannot be considered as an adequate suggestion or motivation to modify, because it is not supported by evidence. The Examiner is kindly asked to supply a reference or references that show(s) that the claimed thickness was indeed desired in the art prior to the present invention. In the absence of such evidence, Applicants respectfully submit that a prima facie case of obviousness has not been established and request withdrawal of the 35 U.S.C. 103(a) rejection.

As to claim 7, the claimed range, i.e., 10Å to 100Å or 1nm to 10 nm, is well outside the range disclosed by the reference, i.e., 50-100 nm. See *Orita* at column 9, line 50. The thinner alloy layer of the claimed invention allows to improve transmittance thereof. See, for example, page 17, line 24 of the specification. The thicker alloy layer of *Orita* greatly reduces the device's transmittance which appears to be the reason why the area of the thick alloy layer of *Orita* should be kept minimum. See, for example, 18 at FIG. 2 and 21 at FIG. 9 of *Orita*. Accordingly, Applicants respectfully submit that claim 7 is patentable over the applied art of record.

New claims 33-39 depend from claim 1 or 7, and are considered patentable at least for the reasons advanced with respect to amended claim 1 and original claim 7. Claims 33-39 are also patentable on their own merits since these claims recite other features of the invention neither disclosed, taught nor suggested by the applied art.

As to claim 33, note the above discussion of claim 7.

As to claim 34, the applied reference clearly fails to teach or suggest the claimed ZnNi. Note also the discussion of claim 6 *supra*.

As to claims 35 and 39, the applied reference clearly fails to teach or suggest the claimed

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As to claims 36 and 38, the applied reference clearly fails to teach or suggest the claimed electrode layer occupying only a middle region of the upper surface of said metal layer without covering a peripheral region of the upper surface of said metal layer, said peripheral region surrounding said middle region. In *Orita*, the electrode layer 18b occupies the entire upper surface of metal layer 18a/21. See FIGs. 2 and 9 as well as the sentence bridging columns 9-10.

As to claim 37, note the above discussions of claims 6 and 34.

Each of the Examiner's rejections has been traversed. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

LOWE HAUPTMAN & BERNER, LLP
Benjamin J. Hauptman
Registration No. 29,310

USPTO Customer No. 22429
1700 Diagonal Road, Suite 310
Alexandria, VA 22314
(703) 684-1111 BJH/KL/klb
(703) 518-5499 Facsimile
Date: December 27, 2005

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